

### **REMARKS**

Claims 1-16, 21-44, 54-59, 67-70, 72-74, and 91-93 are pending in this application. Claims 17-20, 45-53, 60-66, 71, and 75-90 have been cancelled without prejudice or disclaimer. Amendments to the claims have been made to further clarify features of the claimed invention. Support for these amendments is found throughout the original specification, thus no new matter has been added.

### **CLAIM REJECTIONS UNDER 35 U.S.C. SECTION 101**

Claims 27-48, 54-62, 64-70, 72, 73, 75, 81, and 82 stand rejected under 35 U.S.C. Section 101 for being directed to non-statutory subject matter. In support of this rejection, the Examiner asserts that the subject claims “do not include a distinguishable apparatus, computer implementation, or any other incorporated technology”. With respect to the pending claims, Applicants disagree with the Examiner’s assertion and traverses this rejection.

As recently confirmed in Ex parte Lundgren, “there is currently no judicially recognized separate ‘technological arts’ test to determine patent eligible subject matter under Section 101.” (BPAI, September 2005). Accordingly, the Examiner should not “rely on the technological arts test to determine whether a claimed invention is directed to statutory subject matter.” (Annex III of Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility).

This rejection is also improper since the rejected claims produce a concrete, useful, and tangible result. For example, claim 27 and claim 35 each result in the selection of competition finalists responsive to calculated scores. The process recited in claim 54 results in a collection of candidate information packages that have been filtered based on a number of standards. Claim 67 results in a determination of whether an evaluation is aberrant based on a comparison of evaluation indices. As set forth above, the subject independent claims and the claims which depend respectively therefrom each produce a concrete, useful, and tangible result. Therefore, this rejection should be reconsidered and withdrawn.

### **CLAIM REJECTIONS UNDER 35 U.S.C. SECTION 112**

Claims 25, 26, and 68 stand rejected under 35 U.S.C. Section 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Each of the claims has been amended in response to the Examiner's rejection. Therefore, Applicants request that this rejection be reconsidered and withdrawn.

### **CLAIM REJECTIONS UNDER 35 U.S.C. SECTION 102**

Claims 19-22, 27-34, 46-51, 54, 60-62, 65-71, and 81-82 stand rejected under 35 U.S.C. Section 102(e), as being anticipated by U.S. Publication Number 2002/0120538 A1 in the name of Corrie et al. (hereinafter "Corrie). Claims 19-20, 46-51, 60-62, 65, 66, 71, and 81-82 have been cancelled without prejudice or disclaimer.

Claims 21 and 27, as amended, each recite "tracking the performance of said competition finalists and one or more non selected candidates; and determining an actual success indicator for each of said competition finalists and said non-selected candidates." Support for these amendments can be found in the specification at paragraph 198.

Corrie fails to disclose these features. Generally speaking, Corrie discloses a grant management system. Once a grant is awarded, Corrie discloses determining whether the grantee is compliant with the conditions of the grant. However, Corrie fails to teach or suggest gathering further information with respect to applicants that do not receive a grant. In contrast, the present invention tracks the performance of the competition finalists and the non-selected candidates. Amended Claims 21 and 27 further recite determining an actual success indicator for each of the competition finalists and the non-selected candidates. Corrie fails to disclose this feature. Further, because Corrie is solely focused on determining whether grantees are complying with the terms of their respective grants, tracking the performance of competition finalists and non-selected candidates as well as determining an actual success indicator for each of the competition finalists and the non-selected candidates would not have been obvious to a person of ordinary skill in the art at the time of invention.

For the above-stated reasons, Corrie fails to teach or render obvious each of the features recited in amended Claims 21 and 27. Therefore, Applicants request that the rejection of claims 21 and 27 be reconsidered and withdrawn.

Claims 22 and 28-34 depend from amended Claims 21 and 27 respectively and include the features recited therein. Therefore, for at least the reasons set forth above with respect to claims 21 and 27, these claims are also allowable.

Claim 54 recites, *inter alia*, removing all candidate information packages from said candidate pool which do not meet an information completeness standard and a document completeness standard, removing all candidate information packages from said candidate pool which do not meet minimum qualification standards, and removing all candidate information packages from said candidate pool which do not meet one or more discretionary standards. The present claim recites three distinct filtering steps. Corrie fails to disclose each of these three filtering steps. Instead, Corrie discloses determining in a first step if an application is complete and if so, withholding the incomplete applications from further consideration (Corrie at 146) and determining in a second step if a complete application meets basic criteria and compliance (Corrie at 148). Completed applications found to meet the basic criteria and compliance are then passed to the reviewers for review (Corrie at paragraphs 148-150). Thus, Corrie clearly fails to disclose three distinct filtering steps. Since each of the features recited in claim 54 are not disclosed in Corrie, this claim is allowable. Accordingly, Applicants request that this rejection be reconsidered and withdrawn.

Amended claim 67 recites receiving evaluator responses for an evaluation; analyzing said evaluation responses; and determining whether said evaluation should be nullified. Corrie fails to teach each of these features. Paragraphs 152-155 of Corrie describe aggregating each of the raw scores given by reviewers to derive a final raw score. An additional score is then derived by the grants management system using decision models. This additional score is added to the final raw score to obtain a composite score for each application. Grants are then awarded based on the composite score. At no point does Corrie disclose analyzing evaluator responses and nullifying an evaluation based on said analysis. For this reason, amended claim 67 is patentable over Corrie.

With further regard to claim 68, this claim has been amended to recite wherein said analysis comprises comparing at least one of said evaluator responses to one or more evaluator responses given by said evaluator in at least one previously completed evaluation. Support for this amendment is found in the original specification at paragraph 72. Corrie fails to disclose this feature.

Claim 70 as amended recites wherein said analysis comprises comparing an average time between said evaluator responses given in said evaluation to an average time between prior evaluator responses of said evaluator given in at least one prior completed evaluation. Support for this amendment is found in the original specification at paragraph 72. Corrie fails to disclose this feature.

Further, claims 68-70 depend from amended claim 67 and include each of the features recited therein. Therefore, for each of the reasons set forth above, these claims are also patentable over Corrie. Accordingly, Applicants request that the rejection of claims 67-70 be reconsidered and withdrawn.

### **REJECTIONS UNDER 35 U.S.C. SECTION 103**

Claims 1,2, 4-16, 23-26, 35, 36, 38, 40, 41, 43, 45, 56, 58, 59, 64, and 72-75 stand rejected under 35 U.S.C. Section 103(a) as being unpatentable over Corrie. Claims 45, 64 and 75 have been cancelled without prejudice or disclaimer.

Claim 1 recites a pool reduction subsystem coupled to said database for determining whether said candidate data sets having been qualified meet a discretionary eligibility standard. The Examiner asserts that Corrie discloses this feature at paragraphs 146-148. As set forth above, Applicants respectfully disagree with this assertion and reasserts its position that Corrie fails to disclose determining whether said candidate data sets having been qualified meet a discretionary eligibility standard. Corrie also fails to disclose wherein said discretionary eligibility standard varies as a function of the number of said candidate data sets having been qualified. While acknowledging that Corrie fails to disclose this feature, the Examiner alleges that it would have been obvious to one of ordinary skill in the art at the time of invention to include the recited feature as one of the basic criteria taught by Corrie in order

to increase the efficiency of the candidate selection system by allowing the granting agency and grants management system to control the size of the selection pool. Applicants respectfully disagree.

The fact that Corrie requires only that an application be complete and meet only basic criteria and compliance requirements indicates that Corrie is not concerned with controlling the size of the selection pool. Were this not true, then Corrie would teach the use of something more substantial than basic criteria. Further, given that the claimed invention already recites a qualification subsystem for determining whether said candidate data sets are qualified, there would be no need for one of ordinary skill to further incorporate the use of basic criteria as taught by Corrie. For these reasons, this rejection should be reconsidered and withdrawn.

Claims 2, and 4-16 each depend directly or indirectly from claim 1 and include the features recited therein. Therefore, for at least the reasons stated above with respect to claim 1, these claims are allowable over Corrie.

Further regarding claim 11, Corrie fails to disclose a tie-breaking selection module. The Examiner refers generally to Corrie at paragraphs 145-154 as allegedly disclosing this feature. However, Corrie fails to expressly disclose or teach anything related to tie scores between applicants. For this additional reason, claim 11 is allowable over Corrie and this rejection should be reconsidered and withdrawn.

Further regarding claim 12, Corrie fails to disclose a monitoring subsystem coupled to said evaluation subsystem for monitoring evaluations of qualified said candidate data sets, said monitoring subsystem allowing interaction with an ongoing evaluation, said monitoring subsystem allowing nullification of an evaluation when said evaluation is determined to be inconsistent with the requirements of said competition. The Examiner asserts that Corrie teaches these features at paragraphs 145-154. Applicants respectfully disagree with this assertion. The grant management system disclosed in Corrie does not include a subsystem for monitoring the application reviews being conducted by the reviewers or for nullifying such reviews if they are inconsistent with the grant review process. Paragraph 145 discloses receipt of a grant application and paragraphs 146-148 disclose determining if the application

is complete and meets basic criteria and compliance requirements. Paragraphs 149-151 disclose the reviewer assignment process. Each of these steps occurs before the application is evaluated by a reviewer. Therefore, Corrie fails to disclose monitoring of the evaluation and necessarily Corrie also fails to disclose a monitoring subsystem. Paragraph 152 discloses the review process performed by the reviewer. Paragraphs 153 and 154 disclose a process for determining composite scores for each application reviewed. A careful reading of the paragraphs cited by the Examiner clearly indicates that Corrie fails to disclose the monitoring subsystem recited in claim 12. For this additional reason, claim 12 is allowable over Corrie and this rejection should be reconsidered and withdrawn.

Claim 23 depends from claim 21 and includes the features recited therein. Therefore, for at least the reasons set forth above with respect to claim 21, claim 23 is allowable over Corrie.

Regarding claim 24, the Examiner acknowledges that Corrie fails to disclose wherein said subset of said candidate profiles not exceeding a predetermined value in number and said subset of said candidate profiles added to said subset of said sub-pool of candidate profiles equaling said predetermined value in number. However, the Examiner further asserts that it would have been obvious to one of ordinary skill in the art at the time of invention to include the recited feature as one of the basic criteria taught by Corrie in order to increase the efficiency of the candidate selection system by allowing the granting agency and grants management system to control the size of the selection pool. For the reasons set forth above with respect to claim 1, Applicants respectfully disagree with this assertion. Even if the present invention were to incorporate the use of basic criteria as disclosed by Corrie, the resulting invention would not result in the invention as recited in claim 24. Thus, this rejection should be reconsidered and withdrawn.

Claims 25 and 26 depend from claim 24 and include the features recited therein. Therefore, for at least this reason, these claims are also allowable over Corrie. Accordingly, Applicants respectfully request that the rejection of these claims be reconsidered and withdrawn.

Claim 35 recites determining whether candidate applications meet minimum qualification standards and determining whether each candidate application meeting the minimum qualification standards meets a discretionary qualification standard. Corrie fails to disclose each of these features. To the contrary, Corrie discloses only determining if an applicant meets basic criteria. Corrie does not teach determining that the applications meeting the basic criteria also meet some additional discretionary qualification standards. Claim 35 further recites that the discretionary qualification standard is a function of the determined number of candidate applications meeting the minimum qualification standards. The Examiner acknowledges that Corrie fails to disclose this feature but relies again upon Corrie's teaching of using "basic criteria" to support the assertion that the recited feature would have been obvious to one of ordinary skill in the art at the time of invention. The Examiner's continued reliance upon this one limitation in Corrie as a catch all for rendering obvious the unique features claimed in the present invention is an acknowledgment of the clear deficiencies present in Corrie. Here again, the Examiner has offered no tangible evidence to support his assertion that it would have been obvious for the discretionary qualification standard to be a function of said determined number of said candidate applications meeting said minimum qualification standards. Accordingly, this rejection should be reconsidered and withdrawn.

Claims 36-38, 40, 41, and 43 depend from claim 35 and include the features recited therein. Therefore, for at least this reason, these claims are allowable over Corrie.

Claims 55 and 56 depend from claim 54 and includes the features recited therein. Therefore, for at least this reason each of these claims is allowable over Corrie.

Further regarding claims 40, 58, and 59, each of these claims recite a third filter set. Corrie fails to disclose this feature. To the contrary, Corrie discloses first separating applications based on whether or not they are complete and second separating applications based on basic criteria and compliance requirements. In this regard, only two stages of separating applications are disclosed by Corrie. The Examiner has failed to demonstrate where Corrie discloses a third filter set. Further, the Examiner has failed to provide support for the assertion that it would have been obvious to one of ordinary skill in the art at the time

of invention to incorporate a minimum number of academic awards, a minimum number of public awards, a minimum number of honors, a minimum number of leadership roles, a minimum number of student excel bubbles completed, a minimum class rigor average, a minimum amount of community service, a maximum amount of personal circumstance exceptions, and a minimum number of paid hours of employment as part of the evaluation criteria disclosed by Corrie as these factors were commonly used to distinguish scholarship candidates at the time the invention was made. The Federal Circuit has repeatedly made clear that the PTO must provide documented evidence of what constitutes “common knowledge” to one of ordinary skill in the art. See *In re Lee*, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002) (quoting *Zurko*, 258 F.3d at 1385, 59 USPQ2d at 1697, for the proposition that ‘deficiencies of the cited references cannot be remedied by the Board’s general conclusions about what is “basic knowledge”. The Board’s findings must be documented on the record, lest the ‘haze of so-called expertise’ acquire insulation from accountability’). Here again, the Examiner has offered no record evidence of any kind to support his assertion that it would have been obvious to include at least one of the recited features as a third filter set. Consequently the rejection of these claims should be reconsidered and withdrawn.

Regarding claim 72, this claim recites monitoring the evaluation of said candidate package by said evaluator; and interacting with said evaluation responsive to the determination that said evaluation is unfair or inconsistent. Corrie fails to teach, suggest, or render obvious these two features. As set forth above, Corrie teaches only deriving a composite score for each application once it has been reviewed by each reviewer. At no point does Corrie disclose that the reviewers are monitored or that the evaluation is altered in any way in response to a determination that the evaluation is unfair or inconsistent. Thus, Corrie fails to disclose or render obvious each of the features of claim 72. The Examiner further acknowledges that Corrie also fails to expressly disclose additional features recited in claim 72. Accordingly, the rejection of this claim should be reconsidered and withdrawn.

Claims 73 and 74 depend from claim 72 and include the features recited therein. Therefore, for at least this reason, the rejection of these claims should also be reconsidered and withdrawn.



Claims 39, 42, 44, and 57 stand rejected under 35 U.S.C. Section 103 as being unpatentable over Corrie.

Claims 39 and 57 each recite wherein said step of grouping comprises grouping said candidates by one or more of geographical residence, urban/rural upbringing, primary ethnicity, and cultural background. The Examiner asserts that the features “geographical residence, urban/rural upbringing, primary ethnicity, and cultural background” are not functionally involved in the recited step. Applicants respectfully disagree with this assertion. The claims as drafted positively recite functional language. More specifically, claims 39 and 57 each recite features which dictate how grouping is performed. For example, as presently drafted the grouping step could comprise grouping said candidates by geographical residence. Still further, the grouping step could comprise grouping candidates by cultural background and primary ethnicity. Therefore, the cited features should be given patentable weight. Corrie fails to disclose these features and accordingly, claims 39 and 57 are allowable over Corrie.

Claim 42 recites features that, contrary to the Examiner’s assertion, should clearly be given patentable weight. In order to present the claimed features with even more clarity, claim 42 has been amended. More specifically, amended claim 42 recites wherein said set of reading variables includes non-cognitive variables, said non-cognitive variables comprising a positive self-concept variable, a realistic self-appraisal variable, an understanding/navigation of a social system variable, a preference of long-term goals over short-term goals variable, an availability of a strong support person variable, a leadership experience variable, a community service variable, and an interest/knowledge in a non-school field variable. As acknowledged by the Examiner, Corrie fails to disclose or render obvious each of these features. Therefore the rejection of claim 42 should be reconsidered and withdrawn.

Claim 44 has been amended to recite requesting confirmation documents from one or more of said competition finalists. Support for this amendment is found in the specification at paragraphs 105 and 177. Amended claim 44 depends from claim 35 and includes the features recited therein. Therefore, for at least this reason, claim 44 is allowable over Corrie.

Claims 3, 17, and 18 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Corrie in view of U.S. Patent No. 6,928,435 issued to Lee et al. (hereinafter "Lee"). Claims 17 and 18 have been cancelled without prejudice or disclaimer. Claim 3 depends indirectly from claim 1 and includes the features recited therein. As set forth above, Corrie fails to disclose each of these features. Therefore, for at least this reason claim 3 is allowable over Corrie and Lee.

Claims 52 and 53 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Lee in view of Corrie. Claims 52 and 53 have been cancelled without prejudice or disclaimer.

### **Discussion of new claims**

Claim 91 depends from claim 67 and recites wherein said analysis comprises comparing at least one of said evaluator responses given in said evaluation to one or more evaluator responses given by a second evaluator. Support for this claim is found in the original specification at paragraph 72. Corrie taken alone or in combination neither teaches nor renders obvious this feature. Accordingly, claim 91 is allowable.

Claim 92 depends from claim 67 and recites wherein said analysis comprises comparing an average time between said evaluator responses given in said evaluation to an average time between evaluator responses for one or more evaluator responses given by a second evaluator. Support for this claim is found in the original specification at paragraph 72. Corrie taken alone or in combination neither teaches nor renders obvious this feature. Accordingly, claim 92 is allowable.

Claim 93 depends from claim 1 and includes the features recited therein. In addition, claim 93 further recites a tracking subsystem coupled to said evaluation subsystem for tracking said one or more competition finalists and one or more non-selected candidates and determining an actual success indicator for each of one or more performance variables. Support for this claim is found in the original specification at paragraph 198. Corrie taken

alone or in combination neither teaches nor renders obvious these features. Accordingly, claim 93 is allowable.

### **CONCLUSION**

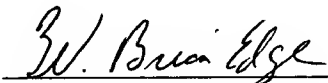
In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event that the transmittal letter is separated from this document and the Patent and Trademark Office determines that an extension and/or other relief is required, Applicants petition for any required relief including extensions of time and authorize the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing attorney docket no. **570862000100**.

Respectfully submitted,

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